

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Upon entry of this amendment, claims 21-31, 59-69 and 71-81 will be pending, wherein it is proposed to amend claims 21, 59 and 71 and cancel claim 70. Entry of these amendments is appropriate in the period after a final rejection because the amendments do not require further search and examination and reduce issues for appeal by overcoming the rejection under 35 U.S.C. § 112, second paragraph.

Claims 21-31 and 59-81 are rejected under 35 U.S.C. § 112, second paragraph for indefiniteness. This amendment proposes to amend claims 21, 59 and 71 to remove the language identified as being indefinite and it is proposed to cancel claim 70, which was also identified as including language that is indefinite. Accordingly, withdrawal of this rejection is respectfully requested.

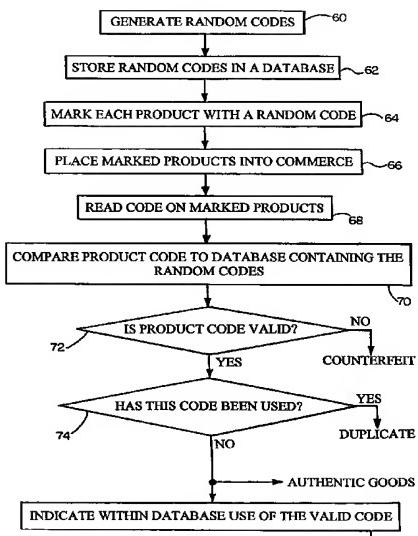
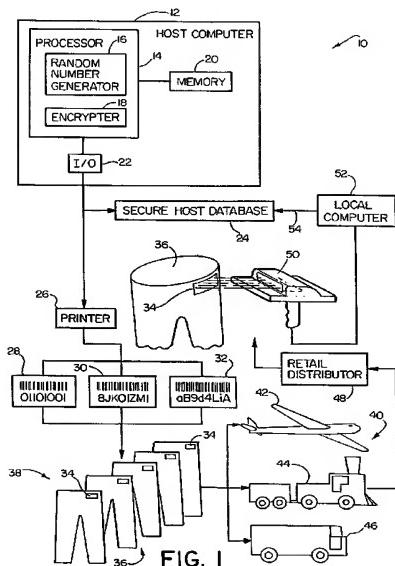
Claims 21-23, 25, 26, 59-61, 63, 64, 70-73, 75 and 76 are rejected for obviousness under 35 U.S.C. § 103(a) in view of the combination of U.S. Patent No. 7,283,630 to Doljack (“Doljack”) and U.S. Patent Application Publication No. 2001/0041214 to Brogger et al. (“Brogger”). This ground of rejection is respectfully traversed.

Independent claims 21, 59 and 71 involve, among other things, the “conception” and “birth” technique discussed during the personal interview and described at page 11, lines 11-26 of the present application. The conception of the code is achieved by marking each of a quantity of the instantiations with one of the code strings of the subset. The code is “born” by capturing the one or more code strings marked on each of the quantity of instantiations and storing the captured one or more code strings within the database on the secure server.

This technique has a number of advantages, none of which are recognized by the prior art. As discussed at page 11, lines 11-26 of the present application, situations can occur where not every originally generated unique code is used, for example, due to failure of the

label application machinery. This can result in codes being included in a database as valid codes even when the codes are not actually included on a product. Thus, these “valid” codes could then be used on counterfeit products. This is avoided using the “conception” and “birth” technique of independent claims 21, 59 and 71 because only those codes that are actually marked on instantiations are actually included in the database against which codes are validated. The combination of Doljack and Brogger does not render independent claims 21, 59 and 71 obvious because the combination does not disclose or suggest at least the “conception” and “birth” technique recited in these claims.

There is no recognition of this problem in Doljack, and accordingly Doljack does not disclose or suggest the “conception” and “birth” solution recited in the pending independent claims. Instead, as illustrated in FIGs. 1 and 2 of Doljack (reproduced below), the codes are generated, stored and then the stored codes are marked on the products (steps 60-64).



Thus, a counterfeiter can defeat Doljack’s system by either stealing labels before they are placed on products, using codes that are stored in the database but not yet printed on labels or using codes that were printed on labels but were discarded because of a failure of the labeling machinery.

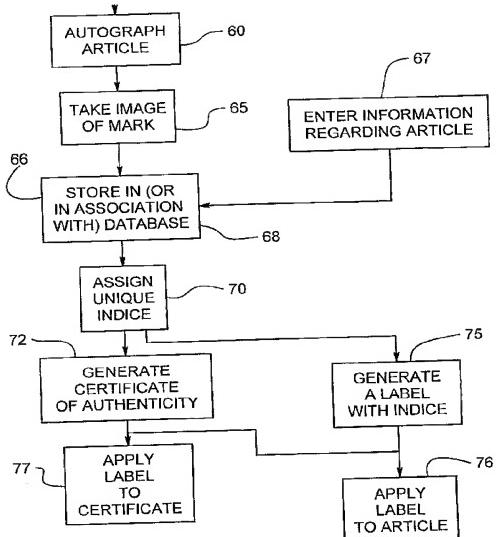
Doljack assumes that a counterfeiter cannot randomly guess codes stored in the database, and only considers that the system can be defeated by counterfeiters copying codes from products at retail outlets.¹ Thus, Doljack not only fails to disclose the “conception” and “birth” technique recited in the independent claims, but Doljack’s failure to recognize the problem addressed by the “conception” and “birth” technique means that such a technique is not obvious in view of the disclosure of Doljack.

Recognizing the deficiencies of Doljack, the rejection relies upon Brogger for the disclosure of the claimed “conception” and “birth” technique. Brogger is quite a different type of system than that of the present invention and Doljack.

Specifically, whereas the present invention and Doljack are concerned with generating a number of codes to mark a number of products, Brogger is concerned with marking on a per-article basis. This is illustrated in Fig. 3 of Brogger (a portion of which is reproduced on the right), in which an autographed article is assigned a unique indice (step 70), a label with the indice is generated (step 75) and the label is applied to the article (step 76). This entire process is presumably repeated for each article.

Brogger discusses two alternative orders for the assignment of an indice to an article, the printing of the label and the storage of the indices in a database, which are as follows:

1. Generate label with indice, place the label on an article and store the information in a database; and
2. Assign the indice to an article and then print the label.²



¹ See, for example, column 9, lines 10-48.

² Paragraph 0040.

Although Brogger is not explicit on this point, it is believed that the second alternative would use an indice that is previously stored in the database.

The rejection relies upon Brogger's disclosure of these two processes as alternatives to support the conclusion that it would have been obvious to modify Doljack to incorporate the first alternative. Specifically, the rejection states that the description of these two processes as alternatives means that the ordering of the steps is interchangeable. This interchangeability apparently recognized by Brogger actually supports the conclusion that it would not have been obvious to modify Doljack by Brogger to arrive at the claimed invention.

If, as asserted in the rejection, the ordering is interchangeable then there is no recognition in the prior art of an advantage to using one ordering versus another. This interchangeability in the system of Brogger is likely due to the fact that Brogger operates on a per-article basis and there is no significant difference between the two orders when operating in this environment. When, however, one considers marking many articles, e.g., one hundred million such as that disclosed in Doljack³, significant differences arise because it would take much more time to generate the label, place it on the article and then store the information in the database for each of the one hundred million products compared to simply labeling products using previously stored codes. Accordingly, one skilled in the art would have modified Doljack to use the second option of Brogger, i.e., use pre-stored codes to print the labels that are then placed on products, because this is the most efficient way to label a large number of products. Thus, the lack of a disclosed advantage of either order in Brogger actually would result in no modification to the order disclosed in Doljack. Otherwise, if Doljack were modified to employ the first option of Brogger, the system of Doljack would be

³ See, for example, column 8, line 65-67 – “suppose that a manufacturer wishes to mark 100 million similar products to verify their authenticity.”

become less efficient for no apparent advantage. Clearly, one skilled in the art would not find it obvious to modify a process to make it less efficient for no apparent advantage.

Additionally, if Doljack were modified to include the first option of Brogger, the combination would operate differently than the claimed invention. This combination would result in generating a label with an indice, placing the label on a product and storing the information in a database on a per-product basis. In contrast, Applicant's independent claims recite that each of a *quantity* of instantiations are marked with code strings, the code strings on each of the *quantity* are captured and stored.

Because one skilled in the art would not have been motivated to modify Doljack to become less efficient and even if one skilled in the art were motivated to combine Doljack and Brogger the combination would not result in what is recited in the independent claims, the combination of Doljack and Brogger does not render the independent claims obvious.

Claims 22, 23, 25, 26, 60, 61, 63, 64, 72, 72, 75 and 76 are patentably distinguishable at least by virtue of their dependency. Accordingly, it is respectfully requested that the rejection of claims 21-23, 25, 26, 59-61, 63, 64, 70-73, 75 and 76 for obviousness be withdrawn.

Claims 24, 27-29, 62, 65-67, 74 and 77-79 are rejected for obviousness under 35 U.S.C. § 103(a) in view of the combination of Doljack, Brogger and U.S. Patent Application Publication No. 2002/0145146 to Miolla et al. ("Miolla"). This ground of rejection is respectfully traversed.

Claims 24, 27-29, 62, 65-67, 74 and 77-79 variously depend from independent claims 21, 59 and 71. As discussed above, the combination of Doljack and Brogger does not render these independent claims obvious. Adding Miolla to the combination does not address the above-identified deficiencies of the combination of Doljack and Brogger, and accordingly

claims 24, 27-29, 62, 65-67, 74 and 77-79 are patentably distinguishable at least by virtue of their dependency and the rejection of these claims should be withdrawn.

Claims 30, 31, 68, 69, 80 and 81 are rejected for obviousness under 35 U.S.C. § 103(a) in view of the combination of Doljack, Brogger and Applicant Admitted Prior Art (“AAPA”). This ground of rejection is respectfully traversed.

The final Office Action has converted the Official Notice that it is well known to use XML to exchange data between computers into AAPA on the basis that Applicant did not properly traverse the Official Notice. Applicant has not purported to have invented the use of XML to exchange data between computers, which was known at the time of the invention. Applicant’s traversal was on the grounds that there is no evidence that it was known to use XML for exchanging transmitted signals as part of an authenticity validation, which is equally true in this Office Action. Instead of providing prior art for these claim features, the Office Action concludes that because XML is known it would have been obvious to use it in the same manner as recited in the claim.

There are, however, many things that are known that would not have been obvious to combine. Thus, for example, at one time it was known to network computers and display a document from one network computer on another of the network computers, where the document included formatting tags – such as a word processing document. While both networked computers and tag-formatted documents were known, the advent of HTML spurred the explosive growth of the World Wide Web, something that was not contemplated at the time when networked computers exchanging tag-formatted documents was known. Thus, merely because XML was known does not support the conclusion that it would have been obvious to employ XML to exchange transmitted signals as part of an authenticity validation. Accordingly, the rejection of claims 30, 31, 68, 69, 80 and 81 for obviousness should be withdrawn.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323, Docket No. 102980.58649US2.

Respectfully submitted,

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